



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BIRCH STEWART
KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH VA 22040-0747

COPY MAILED

DEC 02 2008

OFFICE OF PETITIONS

In re Application of	:
Kurase	:
Application No. 09/994,747	:
Filed: 28 November, 2001	:
Attorney Docket No. 0879-0364P	:

DECISION

This is a decision on the petitions filed on 31 October, 2008, considered as a petition under 37 C.F.R. §1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application, and in the alternative to revive an application under 37 C.F.R. §1.137(b) as having been abandoned due to unintentional delay.

The petition under 37 C.F.R. §1.181 is **DISMISSED**; however, the petition under 37 C.F.R. §1.137(b) is **GRANTED**.

As to the Request to Withdraw
the Holding of Abandonment

Petitioners are directed to the Commentary at MPEP §711.03(c)(I) for guidance as to the proper showing and timeliness requirements for relief under 37 C.F.R. §1.181.

It does not appear that Petitioner has satisfied the showing requirements.

As to Allegations of
Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee. (However, it does not appear that a terminal disclaimer and fee are due here.)

BACKGROUND

The record reflects as follows:

Petitioner failed to reply to the final Office action mailed on 14 August, 2007, with reply due under a non-extendable deadline on or before 14 November, 2007.

The application went abandoned by operation of law after midnight 14 November, 2007.

The Office mailed the Notice of Abandonment on 2 May, 2008.

On 14 May, 2008, Petitioner filed a petition averring, *inter alia*, non-receipt of the Notice in question and supporting that with the complaint of a technical problem resulting from non-availability for online view/downloading of the Office action at the time Email notification was received by Petitioner's firm from the Office. Petitioner averred that Office technical staff confirmed a technical problem (an Email is included with petition), suggesting the possibility that the final Office action might not have been available at the moment of the Email notification—and possibly not until the next day (15 August, 2007). Petitioner indicated that he received the 14 August, 2007, Email Notice of the final Office action, looked to Private PAIR and found only an Examiner Interview Summary—which, Petitioner fails to acknowledge, had been mailed a week earlier on 7 August, 2007—and apparently Petitioner did not inquire¹ further to Private PAIR thereafter. While Petitioner stated that the Office action in question was not received, the actual process was/is that Petitioner received/receives at his office an Email notification of the lodging of an Office action on Private PAIR for Petitioner to download, review and reply. Petitioner acknowledges receiving the notification, and represents only that the Office action in question was not found online on the one occasion Petitioner attempted to look for it—and there is no indication Petitioner looked again. At the very least Petitioner failed to state that he acted to search. The registered practitioner's duties of diligence and candor cannot be assigned to another. Petitioner sought in the alternative revival of the application under the provisions of under 37 C.F.R. §1.137(b), averring unintentional delay. However, because Petitioner failed to file a proper reply (an amendment *prima facie* placing the application in condition for allowance, a Notice of Appeal, or an RCE (with fee and submission under 37 C.F.R. §1.114—see: MPEP §711.03(c)) to a final Office action, that route to pending status also was unavailable to Petitioner. Thus, the petition was dismissed on 2 September, 2008.

On 31 October, 2008, Petitioner re-advanced his requests for relief alternatively under 37 C.F.R. §1.181 and §1.137(b). While Petitioner made no different/greater showing in support of his request to withdraw the holding of abandonment than on the earlier petition, Petitioner did file in support of his petition to revive under 37 C.F.R. §1.137(b) not only the petition and fee, but also

¹ Petitioner has provided no indication that he perceived a diligence/duty requirement to inquire further in the matter. For more than a century the touchstone of proper practice required before the Office has been defined as “no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business.” *ex parte Pratt*, 1887 Dec. Comm'r Pat. 31, 32-33 (1887). (Emphasis supplied.) See also: *In re Mattullath*, 38 App. D.C. 497, 514-15 (1912).

a reply in the form of an RCE (with fee and submission under 37 C.F.R. §1.114), and made the statement of unintentional delay.

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

Out of an abundance of caution, Petitioners always are reminded that the filing of a petition under 37 C.F.R. §1.181 does not toll any periods that may be running any action by the Office and a petition seeking relief under the regulation must be filed within two (2) months of the act complained of (*see*: 37 C.F.R. §1.181(f)), and that those registered to practice and all others who make representations before the Office are reminded to inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.²

STATUTES, REGULATIONS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).³

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a Petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

Allegations as to the Request to Withdraw the Holding of Abandonment

The guidance in the Commentary at MPEP §711.03(c)(I) specifies the showing required and how it is to be made and supported.

Petitioner failed to make the showing required.

² See supplement of 17 June, 1999. The Patent and Trademark Office is relying on Petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

³ 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

Allegations as to Abandonment
Due to Unintentional Delay

The requirements under 37 C.F.R. §1.137(b) have been satisfied.


CONCLUSION

Accordingly, The petition under 37 C.F.R. §1.181 is **dismissed**; and the petition under 37 C.F.R. §1.137(b) is **granted**.

The instant application is released to Technology Center/AU (TC/AU) 2622 for further processing in due course.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the instant decision to ensure that the revival has been acknowledged by the TC/AU in response to this decision. It is noted that all inquiries with regard to that change in status need be directed to the TC/AU where that change of status must be effected—that does not occur in the Office of Petitions.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2⁴) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).


/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

⁴ The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.